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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,670	03/29/2004	Brian N. Tufte	1076.1101110	2974

7590 11/27/2006  
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EXAMINER

NEGRON, ISMAEL

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/811,670

Applicant(s)

TUFTE, BRIAN N.

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/24/05, 5/2/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-17 (Invention I) in the reply filed on April 24, 2006 is acknowledged.

### *Title*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: ~~Lighting Apparatus~~ **Illuminated Rub-Rail/Bumper Assembly**.

### *Abstract*

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use

Art Unit: 2875

thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

In addition, the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it fails to concisely state the subject matter of the instant invention, refers to purported merits or speculative applications of the invention, exceeds 150 words in length, and uses phrases which can be implied. Correction is required. See MPEP § 608.01(b).

4. The Examiner respectfully suggest replacing the abstract with the following:

**A rub-rail assembly including a carrier and an insert. The carrier includes a back support, and first and second legs extending from the back support to form a cavity. The insert includes a main body, and a pair of legs adapted to provide an interference fit with the legs of the carrier when the insert is installed in a seat position with the carrier. The main body of the insert includes a lumen extending lengthwise therethrough for receiving an elongated light source.**

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 2 is indefinite as it fails to define from where does the slit extends into the lumen of the insert. The applicant is advised that in the comparing the claimed invention with the Prior Art, the Examiner assumed that the claimed slit to extend from an outer surface of the insert.

7. If the Examiner's assumption is correct, it is respectfully suggested that Claim 2 be amended as follows:

Claim 2. The rub-rail assembly of claim 1 further comprising a slit that extends from an outer surface of the insert into the lumen of the insert.

8. Claim 3 is rejected for its dependency on rejected Claim 2.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 15-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,921,184 (TUFTE). Although the conflicting claims are not identical, they are not patentably distinct from each other because it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, selecting a given dimension would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a given application.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by BURKITT, III et al. (U.S. Pat. 5,680,496).

11. BURKITT, III et al. discloses an illumination device having:

- **a carrier (as recited in Claim 1), Figure 2, reference number 16;**
- **the carrier having a back support (as recited in Claim 1), Figure 2, reference number 24;**
- **the carrier having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 40;**
- **the first leg and the second leg extending from the back support to form a cavity (as recited in Claim 1), column 3, lines 58-60;**
- **an insert (as recited in Claim 1), Figure 2, reference number 14;**
- **the insert having a main body (as recited in Claim 1), Figure 2, reference number 30;**
- **the insert having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 34;**



- **the first leg being adapted to provide an interference fit with the first leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the second leg being adapted to provide an interference fit with the second leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the main body of the insert having a lumen (as recited in Claim 1), Figure 2, reference number 28;**
- **the lumen extending lengthwise through the main body for receiving an elongated light source (as recited in Claim 1), column 3, lines 44 and 45;**
- **the end of the first and second leg of the carrier defining a slot (as recited in Claim 4), as seen in Figure 2;**
- **the main body of the insert being sized larger than the slot so that when the insert is installed into the seat position, the main body becomes at least partially deformed (as recited in Claim 4), column 3, lines 60-67;**
- **the carrier including one or more insert stops (as recited in Claim 5), Figure 2, reference number 38;**

- **the insert stops extending from the back support of the carrier into the cavity (as recited in claims 5 and 6), as seen in Figure 2;**
- **the carrier including a first insert stop and a second insert stop (as recited in Claim 6), Figure 2, reference number 38;**
- **the first and the second insert stops each including an angled surface (as recited in Claim 6), as seen in Figure 2;**
- **the main body of the insert being adapted to engage the angled surface of the first insert stop and the angle surface of the second insert stop if a sufficiently large force is exerted on the insert toward the carrier (as recited in Claim 7), as evidenced by Figure 2;**
- **the main body including a transparent or semi-transparent material (as recited in Claim 8), column 3, lines 52-54; and**
- **the transparent or semi-transparent material extending from the lumen to an outside surface of the main body (as recited in Claim 8), as seen in Figure 2.**

12. Claims 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by GAGNE (U.S. Pat. 5,499,170).

13. GAGNE discloses an illumination device having:

- **a carrier (as recited in Claim 12), Figure 2, reference number 50;**

- **the carrier having a back support (as recited in Claim 12),**  
Figure 2, reference number 54;
- **the carrier having a first and a second leg (as recited in Claim 12),** Figure 2, reference numbers 51 and 52;
- **the first leg and the second leg extending from the back support to form a cavity (as recited in Claim 12),** column 3, lines 45-50;
- **the carrier having a light receiving cavity or lumen for receiving an elongated light source (as recited in Claim 12),**  
Figure 2, reference number 56;
- **an insert (as recited in Claim 12),** Figure 2, reference number 70;
- **the insert having a main body (as recited in Claim 12),** Figure 2, reference number 74;
- **the insert having a first and a second leg (as recited in Claim 12),** Figure 2, reference numbers 71 and 72;
- **the first leg and the second legs being adapted engage the first and second legs of the carrier when the insert is installed into a seat position with the carrier (as recited in Claim 12),**  
column 4, lines 58-67;
- **the light receiving cavity or lumen of the carrier being positioned behind the insert when the insert is installed into**

- the seat position with the carrier (as recited in Claim 13), as seen in Figure 2;**
- **the insert including at least one region that is transparent or semi-transparent and adapted to allow at least some of the light emitted by a light source to escape therethrough (as recited in Claim 14), Figure 2, reference number 74.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).
15. BURKITT, III et al. discloses an illumination device having:
  - **a carrier (as recited in Claim 1), Figure 2, reference number 16;**
  - **the carrier having a back support (as recited in Claim 1), Figure 2, reference number 24;**
  - **the carrier having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 40;**

- **the first leg and the second leg extending from the back support to form a cavity (as recited in Claim 1), column 3, lines 58-60;**
- **an insert (as recited in Claim 1), Figure 2, reference number 14;**
- **the insert having a main body (as recited in Claim 1), Figure 2, reference number 30;**
- **the insert having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 34;**
- **the first leg being adapted to provide an interference fit with the first leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the second leg being adapted to provide an interference fit with the second leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the main body of the insert having a lumen (as recited in Claim 1), Figure 2, reference number 28; and**
- **the lumen extending lengthwise through the main body for receiving an elongated light source (as recited in Claim 1), column 3, lines 44 and 45.**

16. BURKITT, III et al. discloses all the limitations of the claims, except:

- a slit (as recited in Claim 2);
- the slit extending from an outer surface of the insert into the lumen (as assumed from Claim 2);
- the interference fit of the first and second legs of the insert with the first and second legs of the carrier providing a force that helps keep the slit in a closed position (as recited in Claim 3); and
- the main body including a non-transparent material (as recited in Claim 9).

17. BELL (U.S. Pat. 5,410,458) discloses illumination device having:

- **an elongated member (as recited in Claim 1), Figure 4, reference number 104**
- **the elongated member having a lumen (as recited in as recited in Claim 1), as seen in Figure 4;**
- **the cavity being for receiving the light source (as recited in Claim 1), column 3, lines 30-33;**
- **a slit (as recited in Claim 2), Figure 4, reference number 110;**
- **the slit extending from an outer surface of the insert into the lumen (as assumed from Claim 2), as seen in Figure 4; and**
- **the elongated member including a non-transparent material (as recited in Claim 9), column 3, lines 64-68.**

18. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the slit of BELL in the elongated member of BURKITT, III et al. to be able to easily remove the light source in the event that it needs service or replacement, as per the teachings of BELL (see column 3, lines 51-55). It would have further being obvious to place such slit on the side facing the elongated carrier for presenting a continuous and uniform output surface and for preventing the light source from being accidentally removed from the elongated member, such arrangement inherently forcing the carrier to provide closing force to the slit (as recited in Claim 3).

19. Regarding the main body including a non-transparent material (as recited in Claim 9), it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the non-transparent material of the elongated member of BELL in the insert of the patented device of BURKITT, III et al. to provide a desired illumination effect, as per the teachings of BELL.

20. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

21. BURKITT, III et al. discloses an illumination device having:

- **a carrier (as recited in Claim 1), Figure 2, reference number 16;**

- **the carrier having a back support (as recited in Claim 1), Figure 2, reference number 24;**
- **the carrier having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 40;**
- **the first leg and the second leg extending from the back support to form a cavity (as recited in Claim 1), column 3, lines 58-60;**
- **an insert (as recited in Claim 1), Figure 2, reference number 14;**
- **the insert having a main body (as recited in Claim 1), Figure 2, reference number 30;**
- **the insert having a first leg and a second leg (as recited in Claim 1), Figure 2, reference number 34;**
- **the first leg being adapted to provide an interference fit with the first leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the second leg being adapted to provide an interference fit with the second leg of the carrier when the insert is installed in a seat position with the carrier (as recited in Claim 1), column 3, lines 60-64;**
- **the main body of the insert having a lumen (as recited in Claim 1), Figure 2, reference number 28; and**



- **the lumen extending lengthwise through the main body for receiving an elongated light source (as recited in Claim 1),**  
column 3, lines 44 and 45.

22. BURKITT, III et al. discloses all the limitations of the claims, except the maximum dimension of the lumen being less than 20 mm (as recited in Claim 10) or 10 mm (as recited in Claim 11).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the insert of BURKITT, III et al. to have a maximum dimension of less than 20 mm (as recited in Claim 10) or 10 mm (as recited in Claim 11), since it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, selecting a given dimension would have flown naturally to one of ordinary skill in the art as necessitated by the specific requirements of a given application.

24. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over BURKITT, III et al. (U.S. Pat. 5,680,496) in view of BELL (U.S. Pat. 5,410,458).

25. BURKITT, III et al. discloses an illumination device having:

- **an elongated bumper (as recited in Claim 1)**, Figure 2, reference number 14;
- **the elongated bumper having a lumen (as recited in Claim 1)**, Figure 2, reference number 28; and
- **the lumen extending lengthwise through the elongated bumper for receiving an elongated light source (as recited in Claim 1)**, column 3, lines 44 and 45.

26. BURKITT, III et al. discloses all the limitations of the claims, except the maximum dimension of the lumen being less than 30 mm (as recited in Claim 15), 20 mm (as recited in Claim 16), or 10 mm (as recited in Claim 17).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shape the insert of BURKITT, III et al. to have a maximum dimension of less than 30 mm (as recited in Claim 15), 20 mm (as recited in Claim 16), or 10 mm (as recited in Claim 17), since it has been held by the courts that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). In this case, selecting a given dimension would have flown naturally to one of

Art Unit: 2875

ordinary skill in the art as necessitated by the specific requirements of a given application.

***Relevant Prior Art***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Erkert** (U.S. Pat. 2,959,146), **Butters** (U.S. Pat. 3,865,358), **Tieszen** (U.S. Pat. 5,023,762) and **Beckett** (U.S. Pat. 6,364,293) disclose bumper structures including a carrier having back support and a pair of legs extending from the back support to form a cavity, and an insert having a main body and a second pair of legs adapted to provide an interference fit with the legs of the carrier when the insert is installed in a seat position with the carrier. The insert further includes a lumen extending lengthwise therethrough capable of receiving an elongated light source.

**Winter** (U.S. Pat. 4,625,266), **Brookman** (U.S. Pat. 5,337,225), **Ruh** (U.S. Pat. 6,113,246), **Huang** (U.S. Pat. 6,461,028) and **Hoffman** (U.S. Pat. 6,523,986) disclose illumination devices including a carrier having back support and a pair of legs extending from the back support to form a cavity, and an insert adapted to be frictionally received within the carrier. The insert further includes a lumen extending lengthwise therethrough and housing an elongated light source.

***Conclusion***

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (571) 273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

  
Ismael Negron  
Examiner  
AU 2875